

## REMARKS

### **I. General**

Claims 1, 4, 10, 17-23, and 25-28 are pending in the present application. Claims 1, 4, 10, 17 and 26-28 are withdrawn from consideration as being directed to non-elected claims. Claims 18, 19, and 25 again stand rejected under 35 U.S.C. § 102(b) as being anticipated by the telephone book THE ONE BOOK FOR NORTHERN VIRGINIA for 1993 (hereinafter, *One Book*). Claims 18, 19, and 25 again stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the *One Book*. Claims 18, 20-23 again stand rejected under 35 U.S.C. § 103(a) as being unpatentable over HAWAIIAN AIRLINES IN PARADISE, July 1989, (hereinafter, *Hawaiian Airlines*) in view of the *One Book*. Claims 18, 22, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shedd, United States patent number 2,215,163 (hereinafter *Shedd*) in view of Bullard, Jr., United States patent number 4,968,061 (hereinafter *Bullard*). Claims 19-21 and 23 stand rejected under 35 U.S.C. § 103(a) over *Shedd* in view of *Bullard* and further in view of Lamphere et. al, United States patent number 5,127,674 (hereinafter *Lamphere*).

Applicant respectfully requests withdrawal of the rejections in light of the remarks contained herein. Applicant further requests that the present application be returned to the Board of Patent Appeals and Interferences (the “Board”) as ordered in the Remand mailed July 23, 2004 (the “Remand”).

### **II. Status of Appeal and Applicant’s Request for Return of the Application to the Board**

The present application is on appeal before the Board, having been remanded to the Examiner July 23, 2004 “to consider the prior art submitted by appellants in combination with appellants’ declaratory evidence and the prior art of record,” Remand mailed July 23, 2004 at page 4. Accordingly, the Board ordered the Examiner “[a]fter appropriate consideration and action by the examiner, . . . to return the application to the Board for determination of this appeal on the merits,” *id.*

The Examiner issued an Office Action April 13, 2005 (the “first Office Action”) presenting three alternative rejections of the claims based upon newly applied art, in response to the Board’s order and apparently in anticipation of returning the case to the Board as ordered. Applicant filed a response to the foregoing Office Action July 13, 2005 which fully addressed the rejections then of record, believing that the Examiner’s rejections and the Applicant’s response would be returned to the Board for a determination of the appeal on the merits as ordered.

Now, however, the Examiner has issued an Office Action mailed October 7, 2005 (the “second Office Action”) without returning the application to the Board. The second Office Action again presents the three alternative rejections of the claims set forth in the previous Office Action and adds three alternative rejections (one encompassing the independent claim and two encompassing only dependent claims) based upon the art before the Board prior to the Remand. The Examiner has already considered all of this art. Moreover, the Board has already considered the art forming the basis of the alternative rejections newly set forth in the second Office Action and concluded that the art was so poor with respect to the pending claims that the Examiner was directed to consider new art.

Applicant respectfully asserts that issuance of the second Office Action during the present appeal is contrary to the Remand issued by the Board. Accordingly, Applicant respectfully requests that the present application be returned to the Board as ordered in the Remand.

Moreover, the second Office Action appears to be in contravention to Office policy (see e.g., M.P.E.P. § 706.07 “To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied,” (emphasis added)). Similarly, the foregoing multiple alternative rejections appear to be in contravention to Office policy. For example, “[p]rior art rejections should ordinarily be confined strictly to the best available art,” M.P.E.P. § 706.02. “Merely cumulative rejections . . . should be avoided,” *id.* Also, M.P.E.P. § 707.07(g) directs that the “examiner ordinarily should reject each claim on all valid grounds available, avoiding,

however, undue multiplication of references” (emphasis added). Given that the Office Action sets forth a large number of alternative claim rejections, Applicant respectfully submits that the Office Action fails to confine the rejections strictly to the best available art. Applicant respectfully requests that further delay associated with continued rejections over art which has been shown by Applicant not to meet the elements of the claims be ceased and that the application be returned to the Board for a decision on the merits.

### **III. Official Notice Statements Taken to be Admitted Prior Art**

As acknowledged by the Examiner, Applicant traversed the taking of Official Notice for findings with respect to various aspects of the claims by the Examiner. The Examiner, however, asserts that Applicant’s traversal was inadequate. Specifically, the Examiner states that an adequate traversal of a finding based upon Official Notice is a two step process: (1) Applicant must state their traversal on the record; and (2) Applicant must state why the Official Notice statements are not to be considered common knowledge or well known in the art, second Office Action at page 10. The Examiner concedes that Applicant stated their traversal on the record, but asserts that Applicant did not argue why the statements regarding having taken Official Notice are not to be considered common knowledge or well known in the art, *id.* Applicant respectfully disagrees.

For example, when addressing the Examiner having found that a phonebook (the *One Book*) is a magazine containing articles, Applicant provided a dictionary definitions of a “telephone book,” the “white pages,” the “yellow pages,” an “article,” and an “advertisement” which are clearly contrary to the Examiner’s finding of facts. Applicant has shown, not just by attorney argument, but by clear extrinsic evidence that the Examiner’s position with respect to the finding of fact that a phonebook is a magazine containing a plurality of general interest articles is in error. Moreover, Applicant asserts that it is nonsensical for the Examiner to assert that Applicant has failed to argue why the statements regarding Official Notice made by the Examiner are not to be considered common knowledge when Applicant has provided dictionary definitions (a well accepted source of “common knowledge”) contrary to the Examiner’s findings.

Applicant respectfully asserts that the Examiner cannot use factual findings to define words of the claims contrary to Applicant's disclosure and contrary to the word's ordinary and customary meaning. As set forth in detail at pages 6, 7, and 14 of the Response filed July 13, 2005, Applicant asserts that the ordinary and customary meaning of a phonebook is not a magazine (contrary to the Examiner's assertion that the phonebook is a magazine), that general interest articles are not advertisements, coupons, or recycling information (contrary to the Examiner's assertion that the advertisements, coupons, or recycling information are general interest articles), and that an airline is not a store (Examiner asserts that Hawaiian Airlines is a store). Therefore, Applicant respectfully requests that the Examiner withdraw his Official Notice and factual findings or take Official Notice and make factual findings which are not repugnant to the usual meaning of the words of the claim.

#### **IV. Lexicography**

The Examiner asserts that because Applicant has not asserted that he is his own lexicographer, that a heavy presumption in favor of the ordinary and accustomed meaning is not overcome, second Office Action at pages 7-8. Applicant would welcome the use of the ordinary and accustomed meaning of words in the claim which are not otherwise given special meaning in view of the specification. However, from the Examiner's having made factual findings that a phonebook is a magazine, that an advertisement is a general interest article, and that an airline is a store, it appears that the Examiner has decided to be his own lexicographer rather than using the ordinary and accustomed meaning of the words. Applicant respectfully requests that the Examiner use meanings which are ordinary and customary rather than meanings which are repugnant to the usual meaning of the words of the claim.

#### **V. The Examiner's Reliance on *Bado* to Show Coupons Keyed to Articles Containing Brand Specific Information**

The Examiner states that it is well known in the art to key coupons for brand name products to other articles, second Office Action at page 6. The Examiner relies upon Figure 8 of *Bado et. al*, United States patent number 4,703,423 (hereinafter *Bado*), to support the foregoing statement, id. However, Figure 8 of *Bado* merely shows coupons attached to a

shopping list. Although the shopping list includes a reference to “Coupon Available Below,” there is nothing in the coupon to key the coupon to the shopping list. Moreover, a shopping list is not a general interest article as set forth in the claim. Indeed, even ignoring the fact that a shopping list is not an article, it would be unfair to assert that one’s shopping list was of general interest. Accordingly, Applicant respectfully asserts that the Examiner has not properly provided evidence showing a coupon keyed to an article containing brand specific information.

## **VI. The 35 U.S.C. § 102 Rejections**

Claims 18, 19, and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the *One Book*. The prior arguments with respect to the 35 U.S.C. § 102 rejections based upon the *One Book* submitted by Applicant in the Amendment filed July 13, 2005, are believed to still be applicable to the above rejection of record and are, accordingly, incorporated herein. For the sake of brevity, those arguments will not be repeated herein but rather Applicant will address the new issues with respect thereto raised in the second Office Action and attempt to clarify various positions of the Applicant. Applicant respectfully requests that the Examiner reconsider Applicant’s previous arguments, in combination with the comments set forth below.

Claim 18 recites “a coupon keyed to said at least one of said articles containing said brand specific information.” The 35 U.S.C. § 102 rejection of record fails to address this claim limitation. Moreover, the *One Book* does not contain articles containing brand specific information, or coupons keyed to the articles. Therefore, the 35 U.S.C. § 102 rejection of record is improper because the applied reference does not address each and every element set forth in the claim. Applicant respectfully requests the withdrawal of the 35 U.S.C. § 102 rejection of claim 18 and the claims dependent therefrom.

Claim 19 recites “said magazine is specific to a particular store.” In addressing this aspect of the claims, the Examiner asserts that “the magazine is specific to a particular store (e.g. a pet store),” the second Office Action at page 3. Applicant respectfully points out that the phonebook’s inclusion of all the stores in the northern Virginia area is the opposite of being “specific to a particular store.” Consistent with Applicant’s reading of the *One Book*,

in rejecting claim 18 the Examiner relied upon the *One Book* (the phonebook relied upon by the Examiner as a magazine) having advertisements for various stores (e.g., “Federal Lock and Safe,” “Marinelife,” and “Creatures ‘n Critters”) to meet the articles set forth in the claim. The Examiner later states that the *One Book* is particular to many stores, second Office Action at page 10. Applicant asserts that the *One Book* is not particular to any store, but rather is universal to many stores, particularly when read in light of the present specification. Accordingly, Applicant respectfully requests that the 35 U.S.C. § 102 rejection of claim 19 be withdrawn.

Claim 25 recites “wherein said at least one of said articles includes within its confines references to specific brand information pertaining to products other than said identified product.” The *One Book* does not contain general interest articles that mention brand information pertaining to products other than the identified product, nor does the 35 U.S.C. § 102 rejection of record assert otherwise, see the second Office Action at page 3. Therefore, Applicant respectfully requests withdrawal of 35 U.S.C. § 102 rejection of record.

## **VII. The 35 U.S.C. § 103 Rejections**

Claims 18, 19, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the *One Book*. Claims 18, and 20-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hawaiian Airlines* in view of the *One Book*. Claims 18, 22, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shedd* in view of *Bullard*. Claims 19-21 and 23 stand rejected under 35 U.S.C. § 103(a) over *Shedd* in view of *Bullard* and further in view of *Lamphere*.

The prior arguments with respect to the 35 U.S.C. § 103 rejections based upon the *One Book* and *Hawaiian Airlines* in view of the *One Book* submitted by Applicant in the Amendment filed July 13, 2005, are believed to still be applicable to the above rejection of record and are, accordingly, incorporated herein. Similarly, the prior arguments with respect to the 35 U.S.C. § 103 rejections based upon *Shedd* in view of *Bullard* and *Shedd* in view of *Bullard* and further in view of *Lamphere* submitted by Applicant in the Appeal Brief filed August 15, 2002 and the Reply Brief filed December 20, 2002, are believed to still be applicable to the above rejection of record and are, accordingly, incorporated herein. For the

sake of brevity, those arguments will not be repeated herein but rather Applicant will address the new issues with respect thereto raised in the second Office Action and attempt to clarify various positions of the Applicant. Applicant respectfully requests that the Examiner reconsider Applicant's previous arguments in combination with the comments set forth below.

Applicant reminds the Examiner evidence of secondary considerations has been submitted with respect to the present application which must be considered by the Examiner, see M.P.E.P. § 716.01(a). Applicant has shown a nexus between the commercial success described and attested to by Caleb J. Pirtle and the claimed invention, see e.g., the Amendment filed July 13, 2005 at pages 15-18. The 35 U.S.C. § 103 rejections of record are improper as the Examiner has not given proper weight to the evidence of commercial success submitted by Applicant.

**A. Rejections over *One Book***

The Examiner rejects claims 18, 19, and 25 as being unpatentable over the *One Book*. In setting forth the 35 U.S.C. § 103 rejection based upon the *One Book*, the Examiner states that "[i]t is the Examiner's principle position that the claims are anticipated because of the inerencies [sic: inherencies?] the *One Book* contains articles," the second Office Action at page 4. However, if the foregoing is an attempt to establish inherency of one or more claim limitations, the statement is grossly inadequate. In order to properly establish a rejection based on inherency, "the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art," M.P.E.P. § 2112, citing *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis original). The Examiner's statement that "because of the inerencies the *One Book* contains articles" does not reasonably support a conclusion that the claimed general interest articles dispersed throughout the magazine necessarily flows from the disclosure of the applied art.

In responding to Applicant previously pointing out that the Examiner's statements regarding inherency were insufficient to properly establish a rejection based upon inherency, citing *Continental Can U.S.A. v. Monsanto Co.*, F.2d 1264,1268 (Fed. Cir. 1991), the

Examiner states that “[t]he Examiner is not bound by the claim interpretations in *Continental Can* because this is ex parte examination,” second Office Action at page 10. However, Applicant’s assertion was:

[W]hen the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill, M.P.E.P. § 2131.01 (citing *Continental Can Co. USA v. Monsanto Co.*, F.2d 1264,1268 (Fed. Cir. 1991).

Applicant’s authority is the Manual of Patent Examining Procedure. If the Examiner is not obligated to follow the Office policies and procedures set forth in the Manual of Patent Examining Procedure, what then are the Examiner’s actions bound by? Moreover, a ruling by the Federal Circuit that inherency requires that the “missing descriptive matter is necessarily present in the thing described in the reference” is not claim interpretation as asserted by the Examiner, but rather a statement of the legal requirements of inherency. The Examiner cannot avoid such legal principles in ex parte examination.

In response to Applicant having pointed out that the Examiner had not established his *prima facie* case of obviousness under 35 U.S.C. § 103 because the Examiner had not provided any suggestion of the desirability of doing what was set forth in the claims, the Examiner now asserts that modifying the *One Book* to include articles “would have helped give the reader more information about the coverage of the One Book,” second Office Action at page 4. The claim requires that the articles be “general interest articles”. The Examiner’s statement of motivation proposes the addition of articles which would “give the reader more information about the coverage of the One Book.” The Examiner has not shown or even asserted that one of ordinary skill in the art would have been motivated to have added general interest articles to the *One Book* phonebook.

Moreover, it is well settled that the prior art must suggest the desirability of the claimed invention, M.P.E.P. § 2143.01. There is nothing in the *One Book* nor any other reference of record which would have suggested to one of ordinary skill in the art that adding articles to the *One Book* would have helped give the reader more information about the



coverage of the *One Book*. Thus, the motivation to combine provided by the Examiner is improper, as the motivation must be described in a prior art reference and must detail the benefits of such a modification.

Claim 18 recites “a coupon keyed to said at least one of said articles containing said brand specific information.” The *One Book* does not teach or suggest this limitation, nor has the Examiner shown otherwise in the 35 U.S.C. § 103 rejection of record. Therefore, the proffered combination does not teach or suggest all of the limitations of claim 18, or the claims dependent therefrom, as required for rejection under 35 U.S.C. § 103.

Claim 19 recites “wherein said magazine is specific to a particular store.” The *One Book* does not teach or suggest this claim language. In contrast, by definition the phonebook is not specific to a particular store, but rather is a compilation of all the names of people, stores, and businesses in a covered area, and thus universal to many stores. Moreover, the 35 U.S.C. § 103 rejection of record does not address this claim limitation. Therefore, the 35 U.S.C. § 103 rejection of record should be withdrawn.

Claim 25 recites “said at least one of said article includes within its confines reference to specific brand information pertaining to products other than said identified product.” The 35 U.S.C. § 103 rejection of record does not address this limitation. Therefore, the 35 U.S.C. § 103 rejection of record should be withdrawn.

**B. Rejections over *Hawaiian Airlines* in view of *One Book***

Claims 18, 20-23 are rejected under 35 U.S.C. § 103 as being unpatentable over *Hawaiian Airlines* in view of the *One Book*. The Examiner concedes that *Hawaiian Airlines* does not disclose a coupon, and thus relies upon the disclosure of the *One Book* as teaching brand specific coupons, second Office Action at page 5. However, the rejection of record merely cobbles together a promotional magazine with a coupon and concludes that the invention would have been obvious without properly addressing the requirement in the claim that the coupon be keyed to a general interest article containing brand specific information.

The rejection of record states that “[t]he One Book directly discloses a coupons keyed to articles containing brand specific information (see e.g. ‘Marinelife’, ‘Creatures ‘n Critters’ and P.T. Moran Company Pet Food Supplies’ which disclose ‘Science Diet,’ ‘Iams,’ and ‘Nulro Max’ ‘brand name pet foods’),” *id.* However, coupons containing references to specific brands is insufficient to meet the recited coupons keyed to articles. Moreover, there is nothing in the rejection of record to show that one of ordinary skill in the art would have found it obvious to modify a general interest article to include brand specific information, wherein a coupon is keyed to such an article.

In proffering a modification to *Hawaiian Airlines* to include coupons, the Examiner states that “it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Hawaiian Airlines advertisement (found on the page directly after page 38) to include the brand specific coupons as found in the One Book,” *id.* Applicant notes, however, that the page directly after page 38 provides a Hawaiian Airlines route map, not an advertisement. Even if one were to modify the route map of *Hawaiian Airlines* to include a coupon, the recited general interest articles making reference to an identified product and coupon keyed to a general interest article would not result. Accordingly, the claim is improperly rejected under 35 U.S.C. § 103.

Moreover, there is nothing within *Hawaiian Airlines* or the *One Book* to suggest adding a coupon to an airline route map. Although the Examiner states that “[s]uch a modification would have provided Hawaiian Airlines a method of ensuring that its flight customers take home with them their complementary copy of Hawaiian Airlines so that they could use the coupon in their next purchased flight,” *id.*, there is nothing in this statement to suggest adding the coupon to the airline route map rather than any other place in the magazine.

In proffering a modification to *Hawaiian Airlines* to key coupons to articles, the Examiner states that “it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the Royal Lahaina Luau advertisement to include a coupon for a ‘Hawaiian pig’ or other brand name feature at the luau,” *id.* However, the Royal Lahaina Luau advertisement appearing at page 11 of *Hawaiian Airlines* does not

even reference a “Hawaiian pig” or any other brand name feature. Therefore, one of ordinary skill in the art would have to make the mental gymnastics the Examiner made in order to consider the Royal Lahaina Luau advertisement a general interest article, make an unsuggested modification to the advertisement to include a brand name feature, make an unsuggested modification to the *Hawaiian Airlines* magazine to include a coupon, and make an unsuggested modification to that coupon to key the coupon to the advertisement in order to meet the claim. Applicant respectfully asserts that a proper rejection under 35 U.S.C. § 103 based upon *Hawaiian Airlines* in view of the *One Book* has not been made of record.

In setting forth motivation for modifying the Royal Lahaina Luau advertisement to include a coupon, the Examiner states that “[s]uch a modification would have allowed browsers of Hawaiian Airlines to associate a brand they are familiar with to the luau,” *id.* The foregoing appears to have been impermissibly gleaned from Applicant’s own disclosure, see e.g., page 21, lines 1-16. Because neither *Hawaiian Airlines* nor the *One Book* detail such desirability, the Examiner must have relied upon impermissible hindsight to find a motivation for the combination, see M.P.E.P. § 2142.

Applicant further points out that the 35 U.S.C. § 103 rejection of record relies upon a modification in which the Hawaiian Airlines route map is modified to include a coupon and that a non-existent and unsuggested luau coupon is modified to include reference to a “Hawaiian pig” or other brand name feature not present in the Royal Lahaina Luau. Because each of these proffered modifications are to different portions of the Hawaiian Airlines magazine, no combination has been made of record which meets the claim.

Claim 20 recites that “each of said articles which contains specific brand information is authored under commission by a sponsor of the specific brand in said article.” The rejection of record does not address this claim limitation, see second Office Action at page 4. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record for claim 20.

Claim 21 recites “each of said articles which contains specific brand information is authored under commission of a specific store.” In attempting to address this limitation, the

Examiner states that “the entire magazine is under commission of Hawaiian Airlines,” id. However, the foregoing does not establish that each article is authored under commission of a specific store. Moreover, Applicant points out that an airline is not a store. Applicant therefore respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record for claim 21.

Claim 22 recites “the name of said specific store appears on the front cover of said magazine.” The Examiner asserts that this limitation is met by Hawaiian Airlines appearing on the front cover of the magazine, id. An airline is not a store. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record for claim 22.

Claim 23 recites “the content of each of said articles which contains specific brand information is controlled at least in part by a sponsor of the specific brand in said article.” In addressing this limitation, the Examiner asserts that “airline tickets are controlled at least in part by Hawaiian Airlines,” id. Assuming, *arguendo*, that Hawaiian Airlines has some control over airline tickets, the rejection of record does not establish that a sponsor of the specific brand in each article which contains specific brand information controls the content of each such article. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record for claim 23.

**C. Rejections Over *Shedd* in view of *Bullard***

Claims 18, 22, and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shedd* in view of *Bullard*. Applicant has already addressed these rejections in the present appeal, see e.g., Appeal Brief filed August 15, 2002 at pages 10-13 and the Reply Brief filed December 20, 2002 at pages 5-8. Accordingly, the Examiner’s attention is directed to the Applicant’s arguments already made of record with respect to the 35 U.S.C. § 103 rejections of record based upon *Shedd* in view of *Bullard*.

**D. Rejections Over *Shedd* in view of *Bullard* further in view of *Lamphere***

Claims 19-21 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shedd* in view of *Bullard* and further in view of *Lamphere*. Applicant has already addressed

these rejections in the present appeal, see e.g., Appeal Brief filed August 15, 2002 at pages 11-13 and the Reply Brief filed December 20, 2002 at pages 6-8. Accordingly, the Examiner's attention is directed to the Applicant's arguments already made of record with respect to the 35 U.S.C. § 103 rejections of record based upon *Shedd* in view of *Bullard* and further in view of *Lamphere*.

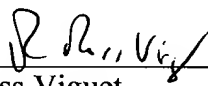
### VIII. Summary

In view of the above amendment, Applicant believes that each of the pending claims in the present application are in condition for allowance. Applicant requests that the Examiner return the present application to the Board as ordered in the Remand.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 58569/P001US/10007125 from which the undersigned is authorized to draw.

Dated: January 6, 2006

Respectfully submitted,

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